

**REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed October 1, 2004 ("Office Action"). Claims 1-25 are pending in the present application and currently stand rejected.

**I. Section 112 Rejections**

The Examiner rejected Claims 9, 13, 16-17, 21, and 24 under 35 U.S.C., second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**1. Claims 9, 13, 16, 17, 21, and 24**

The Examiner rejected Claims 9, 13, 16, 17, 21, and 24 for lack of antecedent basis and Claims 16 and 17 for use of the term "system" in the preamble of method claim. Appropriate amendments have been made. Accordingly, Applicant requests removal of these rejections.

**2. Claims 9, 13, 21, and 24**

The Examiner rejected Claims 9, 13, 21, and 24 as being "vague and indefinite" for utilizing the term "and combinations thereof". Applicant respectfully traverses this rejection. The test for indefiniteness as the Examiner is aware is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." M.P.E.P. §2173.02. This phrase simply means that one could store a combination of the other members of the Markush group. (A search of the USPTO's online database (<http://patft.uspto.gov/netahtml/search-bool.html>) of claims of patents that have been granted since 1976 would reveal that some 35,000+ of these patents utilize the term "and combinations thereof" in their claims.) Thus, Applicant submits that the term "and combination thereof" would be understood by those skilled in the art. Accordingly, Applicant requests removal of these rejections.

## **II. Section 101 Rejections**

The Examiner rejected Claims 14-15 and 18-25 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. While Independent Claim 14 has been amended without prejudice, Applicant nevertheless disagrees with the rejection. The standard, as articulated in *State Street Bank and Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 45 U.S.P.Q.2d 1596 (Fed. Cir. 1998), provides that claimed subject matter is statutory if it produces a useful, concrete and tangible result. *State Street*, 149 F.3d at 1373, citing *In re Alappat.*, 31 U.S.P.Q.2d 1545, 1558 (Fed. Cir. 1994). With regards to this rejection, the Applicant notes that the Examiner indicated that the such a threshold requirement was met, indicating “the claimed invention determines and displays cost depletion date information, thereby producing a useful, concrete, and tangible result.” Office Action, Page 4. Accordingly, the § 101 rejection should not have been made.

## **III. Section 103 Rejections**

The Examiner rejected Claims 1-25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,907,490 issued to Oliver (“*Oliver*”), in view of U.S. Patent No. 5,291,397 issued to Powell (“*Powell*”). Applicant respectfully traverses these rejections for the reasons stated below.

### **1. The Proposed Oliver-Powell Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Claim 1**

As the examiner is aware, a *prima facie* case of obviousness requires a teaching or suggestion of all the claim limitations. The combination of the *Oliver* and *Powell* references as suggested by the Examiner fails to disclose at least the following limitation of Claim 1:

“determine cost depletion date (CDD) information from the project task data and earned value information” (emphasis added)

The Examiner acknowledges in the current Office Action that *Oliver* does not disclose, teach, or suggest “cost depletion date (CDD) information.” Office Action, Pages 4-5 (“*Oliver* does not explicitly disclose determining cost depletion date (CDD)

information..."). Instead, the Examiner relies on *Powell* for disclosure of this feature, citing column 10, lines 47-53 of *Powell*. Specifically, the Examiner indicates that *Powell* "discloses an up to date report that gives actual costa(sic) and deviations from the budget, to provide a warning to management for that particular date...." Applicant respectfully disagrees with this assertion. As support thereof, Applicant includes the entirety of the column 10, lines 47-53 of *Powell*:

"Also, to maintain an up-to-date projection of costs during a project, updated estimates of the actual costs can be entered in the actual cost memory fields N, 43 and P, 44 with a tag or footnote that they are estimates. Any interim report will then give projected actual costs and projected deviations to budget to provide a warning to which management personnel can react."

In the above section, no cost depletion date information is provided. Providing a deviation from budget is not the same as determining a cost depletion date. Thus, Applicant submits that the combination of *Oliver* and *Powell* as suggested by the Examiner, fails to teach or suggest all the claim limitations. For at least this reason, Claim 1 and its dependent claims are allowable. Claims 14 and its dependent claims are allowable for similar reasons.

## **2. The Proposed *Oliver-Powell* Combination is Improper**

As the examiner is aware, a *prima facie* case of obviousness additionally requires a motivation to combine the references. Even assuming for the sake of argument that *Oliver* and *Powell* disclosed each and every element of the invention defined by Claims 1, there is no motivation to combine them. The Examiner's motivation to combine *Oliver* and *Powell* was indicated in the Office Action as follows:

"Both Oliver and Powel are concerned with effective project management, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a CDD in Oliver, as seen in Powell, thereby providing management with additional pertinent information, in order to facilitate more efficient and effective decision making, with respect to cost and budget constraints of the project." (Office Action, Page 5).

The fact that both references relate to project management does not provide a motivation to combine. The alleged motivation stemming from more efficient project management is simply hindsight reconstruction. Nothing in either *Oliver* or *Powell* suggests that the disclosure therein standing alone has efficiency problems. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

Applicant respectfully submits that the Examiner has not provided the requisite motivation for combination of these references as required in establishing a *prima facie* case. For at least this reason, Claim 1 is allowable.

If “common knowledge” or “well known” art is being relied on to supply the required motivation or suggestion to modify the references, Applicant respectfully request that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03. Alternatively, if the Examiner’s personal knowledge is being relied on to supply the required motivation or suggestion to modify, Applicant respectfully requests that an affidavit supporting such facts be provided pursuant to M.P.E.P. § 2144.03 and 37 C.F.R. 1.104(d)(2).

### **3. Official Notice**

The Examiner took Official Notices with regards to Claims 8 and 12. The Applicant traverses these Official Notices. While Applicant disagrees with the Official Notice, the rejection is moot because the independent claims are allowable.

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**CONCLUSION**

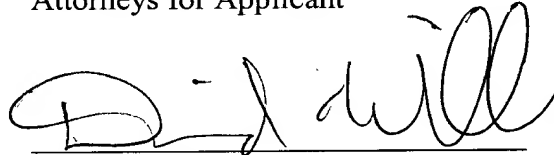
Applicant has made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant does not believe any fees are due. However, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney at the number provided below.

Respectfully submitted,

Baker Botts L.L.P.  
Attorneys for Applicant



David G. Wille  
Reg. No. 38,363  
(214) 953-6595

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**CORRESPONDENCE ADDRESS:**

**at Customer No. 35005**